

## **REMARKS**

This paper responds to the Office Action dated July 1, 2004. A three-month extension of time is requested to respond to the Office Action up to and including January 3, 2005. Please charge our deposit account No. 22-0261 \$510.00 to affect this extension. To the extent that additional funds are required to affect this extension, the Commissioner is authorized to appropriately debit our account.

### ***USE OF TRADEMARKS***

In response to the Examiner's objection to the use of the Post-It ® brand trademark in the claims, the applicant has amended claim 3 in accordance with the Examiner's suggestion.

### ***THE DOUBLE PATENTING REJECTION***

The Examiner has rejected claims 1-20 under the judicially created obviousness type double patenting in view of claims 1-3 of U.S. Patent No. 6,185,862. The applicant is submitting herewith a terminal disclaimer that traverses the rejection

### ***THE REJECTIONS UNDER 35 U.S.C. § 112***

The Examiner has rejected claims 1-20 under 35 U.S.C. § 112. In particular, the Examiner cites in claim 3 the use of the term similar and the use of the trademark Post-It®. The applicant has amended claim 3 in this regard to address the concerns of the Examiner. In connection with claims 1 and 5, the claims have been amended to address the absence of an antecedent basis for the recited "engagement area" and "removable means." Although the


designed to poison insects. One skilled in the art would not be motivated to employ passive mechanical traps or passive poison traps to actively trap an insect. The Shuster patent is the most relevant and applicable reference because it involves an active device. However, for the same reasons that Shuster did not render the parent application anticipated or obvious, claims 18 and 19 are allowable. Shuster *inter alia*, did not disclose a device that allowed the substrate to conform to the insect. Moreover, as discussed above, the device recited in claim 14 is further distinguishable from Shuster's method. Shuster discloses using a device having a first layer of conventional cellophane tape and a compressible pad underneath. Here, the leading edge of the device is comprised of compressible material. When the material is compressed a predetermined distance, the adhesive in the wells is allowed to engage the insect. It is submitted that nothing in the prior art teaches or suggests this novel method of trapping an insect or pest.

**CONCLUSION**

Wherefore, it is submitted that each of the Examiner's rejections has been traversed and, as the case is otherwise in condition for allowance, a notice to that effect is solicited.

Respectfully submitted,

Date: January 3, 2005

  
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applicant has amended claim 1 to further clarify the claim, the basis of the Section 112 rejection was not completely understood.

***THE REJECTIONS UNDER 35 U.S.C. § 102.***

The Examiner has rejected claims 1, 4, 9, 11, 12 and 18 pursuant to 35 U.S.C. § 102 in view of the patent to Hughes, U.S. No. 2,962,836 (the "Hughes Patent").

It is submitted that since the Hughes Patent does not disclose the limitation in claim 1 wherein the substrate will collapse and forms a concave depression which conforms to the shape of the insect that the rejection is not appropriate. The applicant disagrees that Hughes discloses a substrate that may be compressed in this fashion. The substrate disclosed in the Hughes Patent is cardboard or paper and there is nothing inherent in the material that will enable it to be deformed to conform to the shape of the insect. Although conventional cardboard and paper may be compressed to some degree in some circumstances, they do not inherently function to conform to the shape of an insect as claimed by the applicant. To the extent that it is the Examiner's position that the adhesive performs this function, it is submitted that the adhesive and the substrate are separate elements. Accordingly, it is submitted that the rejections of claim 1 and claims 2-13 which depend upon claim 1 are traversed.

In connection with claims 11, 12 and 18, the applicant does not rely upon the additional limitations recited therein to support patentability.

The Examiner has rejected claims 1-3, and 12 under § 102(b) as being anticipated by "Post-It ®" notes. The applicant has amended claim 3 to recite a releasable adhesive. It is

submitted that a Post-It® note and an adhesive similar to that used on cellophane tape do not anticipate claim 2 for the same reasons that the Hughes Patent does not anticipate claim 1. The paper substrate of a Post-It® note will not collapse and form a concave depression therein which conforms to the shape of the insect.

With respect to claim 12, the applicant does not rely upon the limitation recited therein to support patentability.

***THE REJECTIONS UNDER 35 U.S.C. § 103***

***Claims 2-3, 5-8, 10 and 17***

The Examiner has rejected claims 2-3, 5-8, 10 and 17 under Section 103(a) in view of Hughes. Claims 2 and 3 are generally directed to the use of a releasable adhesive. The only description of the adhesive disclosed in the Hughes Patent is an adhesive that will restrain the creature. However, implicit in the Hughes disclosure is an adhesive that will retain a pest based upon the weight of the insect or pest. The Hughes trap is a passive trap and does not require the intervention of an individual. It is submitted that it would not have been obvious to alter the Hughes device to include releasable adhesive because, if such an adhesive was used, the insect would have been prone to escape and would have defeated the entire purpose of the invention. The Examiner argues that it would be obvious to substitute the adhesive used with the Hughes device for that used with transparent tape or Post-It® notes. In this regard the Examiner contends that the applicant did not disclose the problem solved by the type of tape that it disclosed and therefore the problem that is solved is the same. The applicant respectfully

disagrees with the Examiner's position. One of the problems solved by the invention was to be able to easily remove the device and insect from a substrate without leaving material on the surface on which an insect had alighted. In order to achieve this end, the applicant disclosed adhesives with tackiness that ranged from that found in masking tape to those on Post-It ® notes. As explained by the applicant in the specification, the bond sought is not required to be particularly strong or permanent. *See* Specification p. 6. Both masking tape and Post-It® notes employ adhesives that are releasable. This feature is important because it results in a structure that is not designed to adhere to the surface on which the insect has alighted. The device does not require an adhesive that will securely restrain the pest because the invention is directed to a device that is actively used by a person attempting to catch and restrain an insect. The problem addressed by the invention is inherent in its use and in the method that was described and claimed. The use of passive glue traps such as Hughes, address a different problem wherein the engagement of the pest is done without human intervention.

The applicant does not rely upon the limitations recited in claims 5-8 and 10 to support patentability but rather relies upon them in conjunction with the limitations recited in the independent claims.

In connection with claim 17, the applicant respectfully disagrees with the Examiner's contention that it would be obvious to make the substrate of Hughes Patent hydrophilic. It is submitted that the Examiner has not pointed to any motivation to achieve this end except one would want an affinity for liquids when the insect is crushed. However, this teaching is in the

applicant's disclosure, not the prior art. Hughes does not disclose crushing an insect or releasing liquids. Rather, Hughes simply wraps or rolls up the pest for subsequent disposal. Hughes' device retains and traps pests, including large insects, on the surface of the sheet.

Further, because the adhesive that is disclosed comprises a continuous coating across the surface, there is no passage that would allow for the liquids to pass through the adhesive to the hydrophilic substrate. Thus, even if one were motivated to provide a hydrophilic substrate, in order to alter the prior art Hughes Patent one would have to alter the distribution of the adhesive displaced over the sheet. In this regard, Claims 13-16 are further distinguishable. As discussed below, the discontinuous surface recited in claims 13-16 is not taught or suggested by Sherman because Sherman does not disclose an adhesive.

**Claims 13, 14, 15 and 16.**

The Examiner rejected claims 13, 14, 15 and 16 over Hughes discussed above and Sherman, EP O 367 539 A1 ("Sherman"). Claim 13 is directed to a device that does not have a continuous adhesive surface. Claims 14 and 19 are directed to an alternative embodiment depicted in Figs. 18 and 19 and described on page 14 of the specification. In the alternative embodiment, the leading surface of the engagement side of the device is not adhesive but rather an absorbent and deformable material. Neither embodiment is disclosed or suggested by Hughes, Sherman or a combination of both references.

It should be first appreciated that the Sherman reference does not disclose the use of an adhesive and therefore, does not disclose restraining an insect on the device or lure. Rather, the

device emits a viscous insecticide that a flying insect may land on, eat and then leave the location of the lure or device. It is not a pest trap. The applicant therefore disagrees with the examiner that the viscous substance 110 is an adhesive. Rather it is merely a viscous material designed for ingestion by the insect. *See* Sherman, column 3, lines 16-22 and column 3, lines 33-39; column 4 lines 41-44, column 5, lines 39-116. The rationale for providing the poison in a viscous substrate is to allow it to adhere to the plate when the lure is positioned in a vertical orientation. *See* Sherman column 5, lines 20. Moreover, the Sherman disclosure clearly distinguishes the viscous material from an adhesive material that is disclosed as separate structure 122. This adhesive structure is applied around the border of the device so that it may be positioned and adhered to a vertical surface. *See* Sherman, column, 6 lines 16-36.

There is no motivation to combine Sherman and Hughes because they operate in fundamentally different manners. There would be no reason to provide a viscous poison in the Hughes device because it works by mechanically trapping the pest. There is no motivation to provide an adhesive to the Sherman device because it is designed to kill pests by having them ingest poison. For purposes of argument only, even if one were to consider the viscous materials in the wells as “adhesives”, the claimed device is not rendered obvious by the combination advanced by the Examiner. In connection with claim 13, as discussed above, there is still no structure that will conform to the body of the insect. In connection with claim 14, the leading edge of the structure is recited as a compressible material that enables the surface to be deformed to then allow the adhesive to come into contact with the pest. The leading edges of the devices

disclosed by Sherman are not compressible. Referring to Fig 6 the leading edge of the Sherman structure 104 or 106 is described as bosses that hold or define the viscous material. In the alternative embodiment depicted in Figs 7 and 8, the area 112 is described as a plate into which wells of the viscous materials are provided. The leading edge substance is described as molded plastic or extruded material and is not described as deformable or “inherently compressible” material as the Examiner contends. Accordingly, it is submitted that claims 13 and 14 patentability distinguish from the references for these additional reasons.

The discontinuous patterns of adhesive dispersal recited in claims 15 and 16 are not relied upon to support patentability and accordingly the applicant relies upon the various limitations recited in the claims that these claims depend upon.

**Claims 19-20**

In connection with the rejection of claims 19-20, the Examiner has rejected the claims in view of Hughes, Sherman (with respect to claim 14) and in view of Shuster et al. Claims 19 and 20 are directed to a method of capturing an insect using the device recited in claim 14. It is submitted that the teaching of Hughes is not applicable to this situation because the only time in which pressure is applied to the rear of the Hughes device is after the pest has been captured. Hughes discloses a passive trap that does not require human intervention. One would not apply the Hughes disclosure to render the claimed method obvious because it does not teach using the device as an active trapping device. As discussed above, the Sherman device is likewise inapplicable to the present method of trapping a pest. Sherman is also a passive device that is